The Office Action has two further election requirements. Applicants are required to elect a group of either: sequences related to (a) SEQ ID NO:24 or (b) related to SEQ ID NO:25. Applicants are also required to elect one of the following hybrid polymerases: (c) SEQ ID NO:2, (d) SEQ ID NO:4, (e) SEQ ID NO:6, (f) SEQ ID NO:8, (g) SEQ ID NO:10, (h) SEQ ID NO:12, (i) SEQ ID NO:14, (j) SEQ ID NO:16, (l) SEQ ID NO:18, or (l) SEQ ID NO:20. In response to these two requirements, Applicants provisionally elect SEQ ID NO:24 and SEQ ID NO:2. The claims that read on the elected groups are claims 1-11 and 25-31.

Traversal

The foregoing election is made with traverse. According to the MPEP, where claims can be examined together without undue burden, the Examiner must examine the claims on the merits even though they are directed to independent and distinct inventions. See, the MPEP at § 803.01. In establishing that an "undue burden" would exist for co-examination of claims, the Examiner must show that examination of the claims would involve substantially different prior art searches, making the co-examination burdensome. Here, a proper search of the subject matter of Group I would logically identify prior art relating to all of the other groups.

Restriction Groups (a)-(l) are improper

Claim 1 is a genus claim that encompasses all of the sequence set forth in claim 7, which lists SEQ ID NOs. 2, 4, 6, 8, 10, 12, 14, 16, 18, and 20 (*i.e.*, the sequences set forth by the Examiner in Groups (a)-(l)). It contravenes the patent law to require a restriction within the scope of a single claim. Accordingly, Applicants contend that the restriction with regard to Groups (a)-(l) is improper and should be withdrawn.

Under the controlling legal standard, restriction under 35 U.S.C. § 121 of the subject matter of a single claim is impermissible. The Court of Customs and Patent Appeals (CCPA) decided this issue in *In re Weber, Soder, and Boksay,* 198 U.S.P.Q. 328 (C. C. P. A., 1978) ("*Weber*"). In *Weber*, the Court stated that

> [a]s a general proposition, an applicant has the right to have *each* claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant to eventually have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim...
>
> It is apparent that § 121 provides the Commissioner with the authority to promulgate rules designed to *restrict* an *application* to one of several claimed inventions when those inventions are found to be "independent and distinct." It does not, however, provide a basis for an examiner acting under the authority of the Commissioner to *reject* a particular *claim* on the same basis.

Id. at 331-332 (emphasis in the original). The CCPA has also held that refusal to act on a claim in restriction practice in fact amounts to a rejection in *In re Haas*, 179 U.S.P.Q. 623, 625 (C.C.P.A. 1973). As above *Weber* explains, § 121 does not provide a basis for rejecting a particular claim. *See Weber* at 332.

Weber specifically disallows the Patent Office from refusing to examine a single claim on the merits simply because the Patent Office asserts that the claim is drawn to independent and distinct inventions. Rather, the "basic right of the applicant to claim his invention as he chooses" under § 112 is "paramount" over the Patent Office's right to control "such administrative matters as examiner caseloads and amount of searching done per filing fee." *See Weber* at 332.

The restriction for Groups (a)-(l) requires Applicants to elect a single protein. Thus, the Examiner has refused to consider claim 1 as drafted, but instead has insisted upon only examining a very small portion of the subject matter. This restriction is not appropriate under *Weber*. Under the standard of *Weber*, Applicants have the right to have each claim examined on the merits. Restriction of the subject matter of claim 1 into separate claims eliminates the possibility to examine the patentability of the full scope of the subject matter claimed. Patentability resides in the requirements of 35 U.S.C. §§ 101, 102, 103, and 112, not § 121. *See Weber* at 332. If the subject matter of claim 1 is dispersed to multiple claims, then it will never be determined whether claim 1 meets the requirements of §§ 101, 102, 103, and 112. Thus, restriction within a single claim denies Applicants their right to have each claim considered on the merits.

In addition, if the pending restriction was carried through, it would be practically impossible for Applicants to capture the subject matter the Examiner has divided up. If claim 1 is internally restricted as the Examiner proposes, Applicants would be forced to prosecute numerous applications, each drawn to a particular species. Even if Applicant attempted to pursue this course, the scope of coverage of the resulting fragmentary claims would not be equivalent to original claim 1. Thus, restriction within claim 1 improperly limits the scope of Applicants' invention to individual species of the claimed polypeptide in spite of the broader description in the specification.

Further, with regard to Groups (a) and (b), according to the MPEP § 803.02, "[i]f the members of a Markush group are sufficiently few in number or so closely related that a search and examination of the entire claims can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits." This is precisely the case here. For example, the sequences related to SEQ ID NO:24 as encompassed by claim 1 are also related to SEQ ID NO:25 as set forth in the *proviso* in section a of the claim. The same holds true for the sequences related to SEQ ID NO:25. All of the polymerases encompassed by the claims thus share a substantial structural feature in terms of their relationship to two sequences, the reference sequences SEQ ID NO:24 and SEQ ID NO:25. It is

therefore also improper for the PTO to refuse to examine that which applicants regard as their invention as it relates to Groups (a) and (b).

Accordingly, Applicants propose that the Examiner consider allowing Applicants to elect a species encompassed by the generic claims to facilitate prosecution on the merits. For example, a proper species encompassed within the scope of claim 1 is SEQ ID NO:2. The claims that read on the elected species are claims 1-11 and 25-31.

Rejoinder of process claims

As the Examiner is aware, under M.P.E.P § 821.04, if Applicants elect claims directed to the product, and the product claims are allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claims must be rejoined. Process claims, which depend from, or otherwise include all the limitations of the patentable product, will be entered as a matter of right. Therefore, Applicants reserve the right to join withdrawn process claims which include all the limitations of allowable product claims.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

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